

**IN THE UNITED STATES PATENT AND TRADEMARKS OFFICE**

In re application of: Justus, et al.

Application No.: 10. / 615,543

Group No. 3676

Filed: 07/08/2003

Examiner: Bryan A. Fuller

For: Reduced-Density Proppants and Methods of Using Reduced-Density Proppants to Enhance Their Transport in Well Bores and Fractures

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

ATTENTION: GROUP DIRECTOR

**TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT AFTER  
MAILING DATE OF FINAL ACTION, NOTICE OF ALLOWANCE  
OR ACTION THAT CLOSSES PROSECUTION BUT BEFORE  
PAYMENT OF ISSUE FEE (37 C.F.R. § 1.97(d))**

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

(When using Express Mail, the Express Mail label number is mandatory;  
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

**MAILING**

☒ deposited with the United States Postal Service in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

☒ with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

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**TRANSMISSION**

☐ facsimile transmitted to the Patent and Trademark Office, (703) \_\_\_\_\_

Date: 11/2/05

Signature

Tammy Knight

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Transmittal of Information Disclosure Statement after Mailing Date of Final Action or Notice of Allowance But before Payment of Issue Fee [6-5]—page 1 of 3)

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**NOTE:** 37 C.F.R. 1.97(d): An information disclosure statement shall be considered by the Office if filed by the applicant after the period specified in paragraph (c) of this section [i.e., after the mailing date of any final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application], provided that the information disclosure statement is filed on or before payment of the issue fee and is accompanied by:

- (1) The statement specified in paragraph (e) of this section; and
- (2) The fee set forth in § 1.17(p).

**NOTE:** If the information disclosure statement that contains the items required by 37 C.F.R. § 1.97(d) is filed before, or simultaneously with, the payment of the issue fee, then it will be considered. See Notice of April 20, 1992 (1138 O.G. 37-41, 40) and 37 C.F.R. § 1.97(d).

### **TIME OF TRANSMITTAL OF ACCOMPANYING INFORMATION DISCLOSURE STATEMENT**

1. The information disclosure statement transmitted herewith is being filed **after a final action under § 1.113, or a notice of allowance under § 1.311, whichever occurs first, but before, or simultaneously with, the payment of the issue fee.**

**WARNING:** "A petition for suspension of action to allow applicant time to submit an information disclosure statement will be denied as failing to present good and sufficient reasons, since 37 C.F.R. 1.97 provides adequate recourse for the timely submission of prior art for consideration by the examiner." Notice of July 6, 1992 (1141 O.G. 63). But see § 103(b) and (c), limited suspension of action in a continued prosecution application (CPA) filed under § 1.53(d) and in a request for continued examination (RCE) under § 1.114.

### **STATEMENT, PETITION AND FEE**

2. In accordance with the requirements of 37 C.F.R. § 1.97(d):
  - A. Accompanying this transmittal is a statement, as specified in 37 C.F.R. § 1.97(e).
  - B. Applicant submits the petition fee set forth in § 1.17(p) (\$180.00).

**NOTE:** "The petition should be directed to the Group Director of the examining group handling the application. The petition need do nothing more than request consideration of the information being submitted." Notice of April 20, 1992 (1138 O.G. 37-41, 40).

### **FEE DUE**

3. Petition fee due (§ 1.17(p)): \$180.00

(Transmittal of Information Disclosure Statement after Mailing Date of Final Action or Notice of Allowance But before Payment of Issue Fee [6-5]—page 2 of 3)

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## METHOD OF PAYMENT OF FEE

4.

- ☐ Attached is a ☐ check ☐ money order in the amount of \$ \_\_\_\_\_
- ☒ Authorization is hereby made to charge the amount of \$ 180.00
- ☒ to Deposit Account No. 08-0300
- ☐ to Credit card as shown on the attached credit card information authorization form PTO-2038.

**WARNING:** Credit card information should *not* be included on this form as it may become public.

- ☒ Charge any additional fees required by this paper or credit any overpayment in the manner authorized above.

A duplicate of this paper is attached.

Reg. No. 28,626

Tel. No.: (580) 251-3125

Customer No.:



SIGNATURE OF PRACTITIONER

Robert A. Kent

(type or print name of practitioner)

P.O. Box 1431

P.O. Address

Duncan, OK 73536-0440

(Transmittal of Information Disclosure Statement after Mailing Date of Final Action or Notice of Allowance But before Payment of Issue Fee [6-5]—page 3 of 3)

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**STATEMENT FOR INFORMATION DISCLOSURE UNDER  
37 C.F.R. § 1.97(e)**

**NOTE:** A statement must state either: "(1) that each item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement, or (2) that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and to the knowledge of the person signing the statement after making reasonable inquiry, no item of information contained in the information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement." 37 C.F.R. § 1.97(e).

Under the first statement under § 1.97(e), it does not matter whether any individual with a duty of disclosure actually knew about any of the information cited before receiving the search report. The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. See § 609B(5), M.P.E.P., 8th Edition.

**CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\***

(When using Express Mail, the Express Mail label number is mandatory;  
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I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. § 1.8(a)

37 C.F.R. § 1.10 \*

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Date: 11/2/05

Signature

Tammy Knight

(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [6-8]—page 1 of 5)

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NOTE: "Section 1.97(e) makes it clear that a certification could contain either of two statements. One statement is that each item of information in an information disclosure statement was cited in a search report from a patent office outside the U.S. not more than three months prior to the filing date of the statement. Under this certification, it would not matter whether any individual with a duty actually knew about any of the information cited before receiving the search report. In the alternative, the certification could state that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the certification after making reasonable inquiry, was known to any individual having a duty to disclose more than three months prior to the filing of the statement." Notice of January 9, 1992, 1135 O.G. 13-25, at 13. (emphasis added). Thus: "If an item of information is submitted within three months of being cited in a communication from a foreign patent office in a counterpart foreign application, the certification can be properly made regardless of any individual's previous knowledge of the information." *Id.*, 1135 O.G. at 19. See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The date on the communication by the foreign patent office begins the 3-month period in the same manner as the mailing of an Office action starts a 3-month shortened statutory period for reply. If the communication contains two dates, the mailing date of the communication is the one which begins the 3-month period. The date which begins the 3-month period is not the date the communication was received by a foreign associate or the date it was received by a U.S. registered practitioner. Likewise, the statement will be considered to have been filed on the date the statement was received in the Office, or on an earlier date of mailing or transmission if accompanied by a properly executed certificate of mailing or facsimile transmission under 37 CFR 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. 1.10." See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "The certification can be based on present, good faith knowledge about when information became known without a search of files being made." Thus, for example, the certification of § 1.97(e) does not preclude the use of the certification in an application by corporations whose practitioners have over the years reviewed thousands of patents and technical publications, even though they are unaware of the relevance of any one thereof to the application. Notice of January 9, 1992, 1135 O.G. 13-15, at 19.

See § 609B(5), M.P.E.P., 8th Edition:

"If an information disclosure statement includes a copy of a dated communication from a foreign patent office which clearly shows that the statement is being submitted within 3 months of the date on the communication, the copy will be accepted as the required communication. It will be assumed, in the absence of evidence to the contrary, that the communication was for a counterpart foreign application.

"In the alternative, a statement can be made if no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to the knowledge of the person signing the statement after making reasonable inquiry, neither was it known to any individual having a duty to disclose more than 3 months prior to the filing of the statement."

NOTE: A copy of the foreign search report need not be submitted with the certification. Notice of April 20, 1992 (1138 O.G. 37-41, 40).

NOTE: "The phrase 'after making reasonable inquiry' makes it clear that the individual making the statement has a duty to make reasonable inquiry regarding the facts that are being certified. The statement can be made by a registered practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A registered practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the statement without making reasonable inquiry. For example, if an inventor gave a publication to the attorney prosecuting an application with the intent that it be cited to the Office, the attorney should inquire as to when that inventor became aware of the publication and should not submit a statement under 37 C.F.R. 1.97(e)(2) to the Office until a satisfactory response is received. The statement can be based on present, good faith knowledge about when information became known without a search of files being made." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

See § 609B(5), M.P.E.P., 8th Edition.

NOTE: "Although it is recognized that an individual actually becomes aware of the information in the communication from a foreign patent office sometime after it was mailed, the mailing date of such a communication, if it occurs prior to a first awareness of the same information, would determine the date for filing of an information disclosure statement without a fee in a certification procedure under § 1.97(e). Notice of January 9, 1992, 1135 O.G. 13-25, at 19 (emphasis added).

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [8-8]—page 2 of 5)

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**NOTE:** The mere absence of an item of information from a foreign patent office communication is not intended to represent an opportunity to delay the submission of a item known more than three months prior to the filing of an information disclosure statement to an individual having the duty of disclosure under § 1.56. 62 Fed. Reg. 53,131, 53,150 (Oct. 10, 1997).

**NOTE:** The IDS is considered filed as of the date it is received in the PTO, or on an earlier date of mailing or transmission if done so with a properly executed certificate of mailing or facsimile transmission under 37 C.F.R. § 1.8, or if it is in compliance with the provisions for "Express Mail" delivery under 37 C.F.R. § 1.10. See § 609B(5), M.P.E.P., 8th Edition.

**NOTE:** "The certification under § 1.97(e) should be made by a person who has knowledge of the facts being certified. The certification can be made by a practitioner who represents a foreign client and who relies on statements made by the foreign client as to the date the information first became known. A practitioner who receives information from a client without being informed whether the information was known for more than three months, however, cannot make the certification without making reasonable inquiry." Notice of January 9, 1992, 1135 O.G. 13-25 at 19.

**NOTE:** "The term counterpart foreign patent application means that a claim for priority has been made in either the U.S. application or a foreign application based on the other, or that the disclosures of the U.S. and foreign patent applications are substantively identical (e.g., an application filed in the European Patent Office claiming the same U.K. priority as claimed in the U.S. application)." Notice of April 20, 1992 (1138 O.G. 37-41, 39). See § 609B(5), M.P.E.P., 8th Edition.

**NOTE:** "Individuals other than the attorney, agent or inventor may comply with this section by disclosing information to the attorney, agent or inventor." 37 C.F.R. § 1.56(d) and  
"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. § 1.56(c).

### **IDENTIFICATION OF INFORMATION DISCLOSURE STATEMENT FOR WHICH THIS STATEMENT IS BEING MADE**

1. This statement is being made for the Information Disclosure Statement
- ☒ accompanying this statement.
- ☐ filed \_\_\_\_\_ (date)

### **STATEMENT**

**NOTE:** A statement under 37 C.F.R. § 1.97(e) need not be in the form of an oath or a declaration under 37 C.F.R. § 1.68. A statement under 37 C.F.R. § 1.97(e) by a registered practitioner or any other individual that the statement was filed within the 3-month period of either the first citation by a foreign patent office or first discovery of the information will be accepted as dispositive of compliance with this provision in the absence of evidence to the contrary. § 609B(5), M.P.E.P., 8th Edition.

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [8-8]—page 3 of 5)

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2. I, the person(s) signing below state:

- ☒ that each item of information contained in the information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of the information disclosure statement. 37 C.F.R. § 1.97(e)(1).

NOTE: The three month period starts from the mailing date of the foreign patent office communication. Notice of January 9, 1992, 1135 O.G. 13-25 at 19. The mailing date is the "date on the communication by the foreign patent office." Notice of April 20, 1992 (1138 O.G. 37-41, 39).

**OR**

- ☐ that no item of information contained in the information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application and, to my knowledge, after making reasonable inquiry, no item of information contained in this information disclosure statement was known to any individual designated in § 1.56(c) more than three months prior to the filing of the information disclosure statement. 37 C.F.R. § 1.97(e)(2).

NOTE: "The time at which information 'was known to any individual designated in 37 C.F.R. 1.56(c)' is the time when the information was discovered in association with the application even if awareness of the materiality came later." Notice of April 20, 1992 (1138 O.G. 37-41, 40). Section 609B(5), M.P.E.P., 8th Edition.

### IDENTIFICATION OF PERSON(S) MAKING THIS STATEMENT

3. The person making this statement is

*(check each applicable item)*

- (a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
SIGNATURE OF INVENTOR

\_\_\_\_\_  
*(type name of inventor who is signing)*

- (b) ☐ a person who is substantively involved in the preparation or prosecution of the application, and who is associated with the inventor, with the assignee, or with anyone to whom there is an obligation to assign the application (37 C.F.R. § 1.56(c)) and who signs below.

\_\_\_\_\_  
SIGNATURE OF PERSON MAKING STATEMENT

\_\_\_\_\_  
*(type name of person who is signing)*

\_\_\_\_\_  
Address of person who is signing

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [6-6]—page 4 of 5)

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(c) ☒ the practitioner who signs below on the basis of the information:

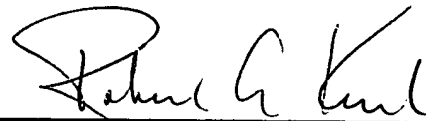
(check each applicable item)

- ☐ supplied by the inventor(s).
- ☐ supplied by an individual designated in § 1.56(c).
- ☒ in the practitioner's file.

Reg. No.: 28,626

Tel. No. (800) 251-3125

Customer No.:



**SIGNATURE OF PRACTITIONER**

Robert A. Kent

(type or print name of practitioner)

P.O. Box 1431

P.O. Address

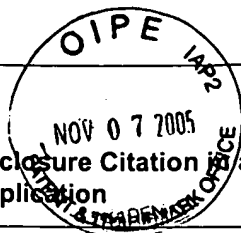
Duncan, OK 73536-0440

(Statement for Information Disclosure under 37 C.F.R. § 1.97(e) [8-8]—page 5 of 5)

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PTO-1449  Information Disclosure Citation in an Application	Application No. <b>10/615,543</b>	Applicant(s) <b>Justus, et al.</b>	
	Docket Number <b>2003-IP-010083U1</b>	Group Art Unit <b>3676</b>	Filing Date <b>07/08/2003</b>



### U.S. PATENT DOCUMENTS

INIT.	DOCUMENT NO.	ISSUE/PUB. DATE	NAME	CLASS	SUBCLASS	FILING DATE
	3,123,138	03/03/64	Robichaux	166	33	08/23/62
	3,199,590	08/10/65	Young	166	33	02/25/63
	3,297,086	01/10/67	Spain	166	33	03/30/62
	3,308,885	03/14/67	Sandiford	166	33	12/28/65
	4,031,958	06/28/77	Sandiford, et al.	166	270	06/13/75
	5,285,849	02/15/94	Surles, et al.	166	295	07/06/92
	5,836,391	11/17/98	Jonasson, et al.	166	295	07/16/96
	6,302,207 B1	10/16/01	Nguyen, et al.	166	276	02/15/00

### FOREIGN PATENT DOCUMENTS

INIT.	DOCUMENT NO.	DATE	COUNTRY	CLASS	SUBCLASS	TRANSLATION	
						Yes	No
	EP 1362978A1	11/19/03	European	E21B	43/02	X	

### NON-PATENT DOCUMENTS

INIT.	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	Date

EXAMINER	DATE CONSIDERED
EXAMINER: Initial if citation considered, whether or not citation is in conformance with MPEP § 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to the applicant.	